

REMARKS

Claim Amendments

Claims 1-35 were previously cancelled without prejudice to their re-filing in this or another related application. Applicant has amended claim 36 so that it is drawn to a method of cleaving RNA comprising SEQ ID NO: 2460 encoded by a mammalian VEGFr1 gene. Amended claim 36 is fully supported by the specification as filed, for example, at pages 7, 8, 9, 12, 33, 53, 69, and Tables I and II (referring to GenBank Accession No. NM_002019 for VEGFR1 RNA, SEQ ID NO: 2460). Claim 36 and dependent claims 37-40 and 56 have been amended to recite the term “short interfering ribonucleic acid” or “siRNA”. Support for this amendment can be found, *inter alia*, at pages 1, 7, 12, 64 and throughout the application. Dependent claims 44-46 and 49-51 have been amended to include the term “one or more”. Support for this amendment can be found, *inter alia*, at page 15, line 11; page 16, line 22; page 21, line 33; page 22, line 1; page 26, line 20 and throughout the application. Dependent claims 44, 45, 49, and 50 have been amended to include the term “present”. Support for this amendment can be found, *inter alia*, at page 16, line 16 to page 17, line 4; page 17, line 14 to page 19, line 3, and throughout the application.

Amendments to the claims are made without prejudice and do not constitute amendments to overcome any prior art or other statutory rejections and are fully supported by the specification as filed. Additionally, these amendments are not an admission regarding the patentability of subject matter of the canceled or amended claims and should not be so construed. Applicant reserves the right to pursue the subject matter of the previously filed claims in this or in any other appropriate patent application. The amendments add no new matter and applicants respectfully request their entry.

The Sequence Listing

Applicants have enclosed a substitute sequence listing (CRF (1 CD) and duplicate CDs (2 CDs) in lieu of paper copy) and request its entry in place of the previously entered sequence listing. The sequence listing adds SEQ ID NOs: 2456-2460. These sequences are

supported in the original application; for example, SEQ ID NOs: 2456-2459 are PCR primer sequences disclosed on page 138 of the instant specification. SEQ ID NO: 2460 represents GenBank entry NM_002019 (see pages 7, 8, 9, 12, 33, 53, 69, and Tables I and II). Accordingly, the additional primer sequences and the sequence of NM_002019 are included in the CRF as requested by the Office Action.

Incorporation by Reference specification paragraph

Applicant has requested that a paragraph incorporating the substitute sequence listing by reference be inserted into the specification.

As required by 37 C.F.R §§ 1.821(f) and 1.825(a)-(b), Applicant submits that the duplicate CD-Rs submitted in lieu of the substitute paper copy and the CD-R submitted as the substitute computer-readable copy are identical in content. The sequence listing adds no new matter and applicants respectfully request its entry into the application.

Priority

The Office afforded a priority date of 9/18/2003 to the previously claimed invention because allegedly none of the priority applications disclose the primer sequence of SEQ ID NO: 2456. Applicant erroneously assigned SEQ ID NO: 2456 in the previous response to GenBank Accession No. NM_002019, which had been previously assigned to the primer in the specification. Claim 36 has been amended above to recite a method of cleaving SEQ ID NO: 2460, which corresponds to GenBank Accession No. NM_002019. Given that GenBank Accession No. NM_002019 was disclosed in the priority applications, Applicant believes that the instant application is entitled to a priority date of at least November 30, 2001 for the reasons below.

The present application is a continuation-in-part of McSwiggen USSN 10/664,767, filed on September 16, 2003, which is a continuation-in-part of McSwiggen, PCT/US03/05022, filed February 20, 2003, which claims the benefit of Beigelman USSN 60/358,580 filed February 20, 2002, of Beigelman USSN 60/363,124 filed March 11,

2002, of Beigelman USSN 60/386,782 filed June 6, 2002, of McSwiggen, USSN 60/393,796 filed July 3, 2002, of McSwiggen, USSN 60/399,348 filed July 29, 2002, of Beigelman USSN 60/406,784 filed August 29, 2002, of Beigelman USSN 60/408,378 filed September 5, 2002, of Beigelman USSN 60/409,293 filed September 9, 2002, and of Beigelman USSN 60/440,129 filed January 15, 2003, and which is a continuation-in-part of Pavco, USSN 10/306,747, filed November 27, 2002, which claims the benefit of Pavco USSN 60/334461, filed November 30, 2001, a continuation-in-part of Pavco, USSN 10/287,949 filed November 4, 2002, and a continuation-in-part of Pavco, PCT/US02/17674 filed May 29, 2002.

The claims presented above all find support in, inter alia, the priority applications. For example, support for double stranded nucleic acid molecules targeting SEQ ID NO: 2460 (corresponding to GenBank Accession No. NM_002019 for VEGFr1 RNA) can be found in Table III (page 416) of the 60/363,124 application, filed March 11, 2002, and on page 55 of the 60/334,461 application, filed November 30, 2001. Therefore, the present invention is entitled to a priority date of at least November 30, 2001.

35 USC § 112, Second Paragraph Rejection

The Office rejected claims 36-56 under 35 USC § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office alleges that it is unclear how contacting a double stranded nucleic acid molecule with SEQ ID NO: 2456, a primer, will result in cleavage of RNA encoded by the mammalian VEGFr1 gene. Applicant respectfully disagrees.

SEQ ID NO: 2456 was erroneously assigned in the previous response to GenBank Accession No. NM_002019. Claim 36 has been amended to recite a method of cleaving SEQ ID NO: 2460, which corresponds to GenBank Accession No. NM_002019, thus

rendering the rejection moot. Applicant respectfully requests withdrawal of the 35 USC §112, second paragraph rejection.

35 USC § 112, First Paragraph Rejection

The Office rejected claim 36 under 35 USC § 112, second paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Office alleges that Applicant has not described or contemplated targeting a primer specific for VEGFr1, SEQ ID NO: 2456, to achieve cleavage of SEQ ID NO: 2456. Applicant respectfully disagrees.

As noted above, SEQ ID NO: 2456 was erroneously used in the previous response with reference to GenBank Accession No. NM_002019. Claim 36 has been amended to recite a method of cleaving SEQ ID NO: 2460, which corresponds to GenBank Accession No. NM_002019, thus rendering the rejection moot. For example, the specification teaches the subject matter encompassed by claim 1, inter alia, at pages 6-8, 47-55, 82-83 132-133, and Figures 12-13. Applicant respectfully requests withdrawal of the 35 USC §112, first paragraph rejection.

35 U.S.C. § 102 Rejections from previous Office Action mailed 10/19/2005

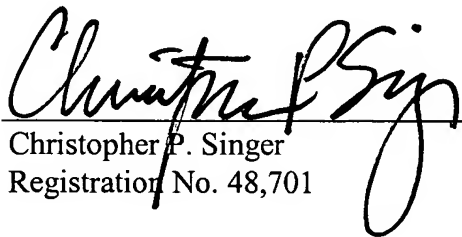
The Office Action states that “rejections under 35 U.S.C. 102 and 35 U.S.C. 103 of the office action mailed 10/19/2005 are considered moot in view of the instant claim amendment inserting SEQ ID NO: 2456 as the target sequence”. Applicant submits that this same reasoning is applicable with respect to SEQ ID NO: 2460. However, Applicant herein restates and incorporates the previous response submitted on April 11, 2006 with regard to the rejections as may be applied to the presently claimed invention.

CONCLUSION

Applicant respectfully requests the claim amendments to be entered and the remarks considered. Applicant believes that with this amendment, the claims are in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,
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